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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,579	06/15/2005	Josephus Arnoldus Henricus Maria Kahlman	NL021436	9055

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EXAMINER

PHAM, TUAN

ART UNIT PAPER NUMBER

2618

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/538,579

Applicant(s)

KAHLMAN ET AL.

Examiner

TUAN A. PHAM

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 06/15/2005 has been considered by Examiner and made of record in the application file.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, the recitation " checking chip data to authorize/deny reading/writing on said main data carrier" renders the claim indefinite because the forward slash (/) are not clear as to what are being claimed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 3/2, 3/1, 4/3, and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Mitsumoto (Pub. No.: US 2002/0177407).

Regarding claim 1, Mitsumoto teaches a portable radio-communication device comprising (see figure 1, portable telephone 10):

a display for displaying data (see figure 2, display 21, [0046]),

a radio transmission/reception unit (see figure 5, non-contact type I/F section 30, IC card antenna 31) for transmitting a powering signal to a contact-less chip (see figure 5, IC card 80) associated with a main data carrier (read on electronic ticket processing section) and for receiving a signal returned by said chip, said returned signal carrying chip data relating to said main data carrier (see figure 5, figure 6, [0051-0058]),

a reading and/or writing unit for reading and/or writing data on said main data carrier (see figure 5, reader/writer 83), and

processing means for processing said chip data so as to execute the following actions: writing chip data on said main data carrier (see figure 2, CPU 13, [0051-0058]).

Regarding claim 2, Mitsumoto further teaches generating a radio communication signal for communication over a radio communication network wherein said radio transmission/reception unit comprises: adaptation means for adapting the frequency of said radio-communication signal to an operating frequency of said contact-less chip, so as to generate said powering signal, demodulation means for demodulating said return signal so as to retrieve said chip data (see figure 4, figure 6, [0055-0058]).

Regarding claim 3/2, Mitsumoto further teaches modulation means for modulating said powering signal with data, called device data, so as to transmit said device data to said contact-less chip (see figure 4, figure 6, [0055-0058]).

Regarding claim 3/1, Mitsumoto further teaches modulation means for modulating said powering signal with data, called device data, so as to transmit said device data to said contact-less chip (see figure 4, figure 6, [0055-0058]).

Regarding claim 4/3, Mitsumoto further teaches transmit device data relating to a request for storing specific data in said chip, and transmit device data relating to a request for retrieving specific data stored in said chip (see figure 4, figure 6, reader, writer, [0055-0058]).

Regarding claim 5, Mitsumoto teaches a storage unit comprising a main data carrier and a contact-less chip associated with said main data carrier, said contact-less chip comprising (see figure 5):

receiving means for receiving a powering signal sent by a portable radio communication device (see figure 5, device 80 receiving the signal R2 from the mobile phone 10),

processing means, memory means, and transmitting means for executing of the following actions (see figure 5, elements 82, 83, and 84):

if said powering signal carries device data relating to a request for retrieving specific data stored in said memory means, transmitting said specific data (retrieve and transmit the ticket data from device 80, [0044-0058]).

Regarding claim 6, Mitsumoto further teaches said portable radio-communication device comprises a reading/writing unit for reading/writing data in said main data carrier when said main data carrier is inserted in said portable radio-communication device, and said specific data is a user-defined data input by a user via said portable radio-communication device, said user-defined data being intended to be used by said portable radio-communication device to authorize reading/writing on said main data carrier (see figure 4, contact type IC card reader/writer 23, [0045-0050]).

Regarding claim 7, Mitsumoto further teaches said portable radio-communication device comprises a reading/writing unit for reading/writing data on said main data carrier when said main data carrier is inserted in said portable radio-communication device, said specific data being main data intended to be written in said main data carrier (see figure 4, contact type IC card reader/writer 23, [0045-0050]).

Regarding claim 11, claim 11 is rejected the same reason of claims 1 and 5.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumoto (Pub. No.: US 2002/0177407) in view of Hino et al. (Pub. No.: US 2001/0011012, hereinafter, "Hino").

Regarding claim 8, Mitsumoto disclosed invention, but fails to disclose a caddy in which said main data carrier is packed and said contact-less chip is embedded. However, Hino teaches such features (see figure 4, figure 7, figure 10, chip 4, caddy 7, tape 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Hino into view of Mitsumoto in order to improve handlability as suggested by Hino at col.1, [0012].

Regarding claims 9-10, Mitsumoto teaches a method of manufacturing a storage unit, said method comprising (see figure 5):

providing main data on a main data carrier (see figure 3, memory 35a),
providing at least program instruction on a contact-less chip (read on IC card 30)
that comprises receiving means for receiving a powering signal carrying data,
processing means, memory means, and transmitting means for transmitting a signal carrying data said program instructions being intended for the execution of the following

actions when executed by said processing means (see figure 3, memory 35a, antenna 31, [0035-0041]):

upon reception of a powering signal that carries a request for storing specific data in said chip, storing said specific data in said memory means (see figure 5, electronic ticket is store in the memory 35a, [0035-0041]).

It should be noticed that Mitsumoto fails to teach embedding said contactless chip in a caddy, and packaging said main data carrier in said caddy. However, Hino teaches such features (see figure 4, figure 7, figure 10, chip 4, caddy 7, tape 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Hino into view of Mitsumoto in order to improve handlability at suggested by Hino at col. 1, [0012].

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In order to expedite the prosecution of this application, the applicants are also requested to consider the following references. Although Oba et al. (U.S. Pub. No. 2004/0077313), Shimazaki et al. (U.S. Pub. No. 2002/0060969), and Ayatsuka (U.S. Pub. No. 2004/0092231) are not applied into this Office Action; they are also called to Applicants attention. They may be used in future Office Action(s).

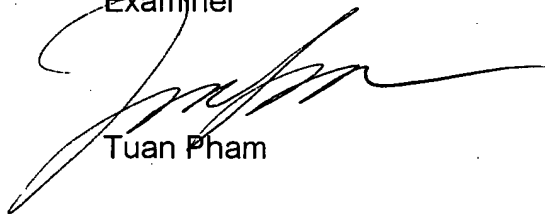
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A. Pham whose telephone number is (571) 272-8097. The examiner can normally be reached on Monday through Friday, 8:30 AM-5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Anderson can be reached on (571) 272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit 2618
November 21, 2006
Examiner



Tuan Pham

Supervisory Patent Examiner
Technology Center 2600



Matthew Anderson